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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,990	09/15/2005	James Barwick	6573P002	1042
<div>7590      03/20/2008</div> <div>Blakely Sokoloff Taylor &amp; Zafman 7th Floor 12400 Wilshire Boulevard Los Angeles, CA 90025</div> <div>EXAMINER RUHL, DENNIS WILLIAM</div> <div>ART UNIT      PAPER NUMBER</div> <div>3689</div> <div>MAIL DATE      DELIVERY MODE</div> <div>03/20/2008      PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/549,990

**Applicant(s)**

BARWICK ET AL.

**Examiner**

Dennis Ruhl

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date 2/5/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,26,28,30, it is not clear as to what applicant is claiming as far as a system goes. These independent claims do not contain any kind of transitional phrase that identifies where the preamble ends and where the body of the claim begins (i.e. comprising, consisting, or consisting essentially of). As an example claim 1 reads:

*A consignment inventory management and reconciliation system wherein there is tracking and reconciliation of:*

- a. first items shipped to a buyer from a seller and that are located at the buyer's consignment inventory location;*
- b. second items shipped to the buyer by the seller, that have not been billed by the seller and cannot be found at the buyer's consignment inventory location; and*
- d. third items not shipped to the buyer by parties other than the seller, can be found at the buyer's consignment inventory location, and are of the same identity as items provided on consignment by the seller to the buyer.*

The claim never actually ever recites anything structurally about the system that the claim is supposed to be directed to. What is the system that is being claimed made

up of? There has to be at least two real world tangible items of structure claimed for there to be anything claimed that could even be considered as a system. These claims do not recite any structure and are essentially claiming the intended use of the unknown and unclaimed system, which renders the claims as indefinite. The same applies to all of the dependent claims. None of them recite any structure that could possibly define a system. A system claim falls into the statutory class of invention that is called an "apparatus" type of claim. In these types of claims it is structure that is recited. In this case applicant has not recited any structure at all. As far as a system goes, the examiner has no idea as to what applicant is claiming. Any prior art application to the claims is done by the examiner as the indefinite claims are best understood.

Also for all of the claims 1-30, it is not clear as to what statutory class of invention the claims fall into due to the fact that there is no structure recited, and due to the fact that some of the claims are seen as reciting more of what would be considered the intended use of the system. One wishing to avoid infringement would not be able to reasonably determine what statutory class of invention is being claimed, other than assuming it is apparatus based on the fact that a system is being claimed. However, due to a lack of structure claimed, one would be unclear as to what statutory class of invention is being claimed.

For claim 2, what is meant by claiming that the system "ages" the first items? This is not clear. What does this mean?

For claim 6, what is meant by "one:zero"? Is the colon supposed to be a comma? Also, applicant has claimed "a positive number, and a negative number".

What is meant by this? Should the “and” be an “or”? Additionally, what is meant by “with a number of decimal places”? What is with a number of decimal places? This is not clear.

For claims 8-17, applicant has claimed when a particular transaction description is used. What does this have to do with the system that is defined by structure? This seems to be just descriptive language directed to the intended use of the unknown system. Reciting what may be done in the future is not a recitation to any structure. Also, for claim 17, the word “count” does not appear in claim 7, so what does this refer to? There does not appear to be antecedent basis for this term in claim 7.

For claim 29, the language “and cannot be found at the buyer’s consignment inventory location” seems to contradict the language of claim 28 that recites “wherein second items can also be found at the buyer’s consignment location”. Are the 2<sup>nd</sup> items at the consignment location or not? Also, the way the claim is written it is not entirely clear as to whether or not the second items recited in claim 29 are a 2<sup>nd</sup> set of second items or if this is actually referring to the second items that was recited in claim 28. This is not clear.

For claim 31, this claim recites that it is directed to a computer usable medium that can cause a processor to execute the steps recited in claim 1. Claim 1 is a system claim and not a method claim so what steps are being referred to? Claim 31 does not appear to be a proper dependent claim because it must include all of the limitations of claim 1, which is a system claim and not a method claim. To this extent, it is not clear at all what claim 31 is reciting.

Prior art will be applied to the claims in an attempt to try to address whatever the examiner best believes is being claimed. Due to the very vague and indefinite claims this is done to try to show applicant some related prior art, but until the applicant actually amends the claims to recite some structure, the examiner really has no idea what is being claimed as far as a system goes.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Guidice et al. (6463420).

Guidice discloses a system for managing and tracking items shipped from a seller to buyers. The system is capable of tracking 1st, 2nd, and 3rd items as seems to be claimed. The system will identify when items are delivered to their destination and their status during shipment (cl 4). The language claimed relating to where the items are or the fact that they were "shipped" (past tense), billed or not billed, is noted but is not seen as defining anything more to the system for tracking 3 items. The system tracks by a tracking number (claimed item number). Of interest is column 1, lines 39-52; column 5, lines 12-column 6, line 39. Most of the claims are reciting limitations that

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have nothing to do with the structure of the system and are directed to non-functional descriptive material. As an example for claim 5, the "transaction" is not a structural part of the system and defines nothing to the system. In claims 8-17, applicant is reciting when certain terms are used (bill, use, dispose, etc.) and this has nothing to do with the system structurally. Claim 18 is reciting when reconciliation takes place. This has nothing to do with a recitation directed to structure of the system. Due to the indefiniteness of the claims and the fact that most of the claims are reciting non-functional descriptive material not related to the system itself, the claims as they are best understood by the examiner are anticipated by Guidice.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-27,31 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-27,31 of copending Application No. 10/394,837. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. As the claims are best understood by the examiner, both sets of claims are claiming the same invention. It is believed that if one were to infringe the instant pending claims 1-27,31, one would necessarily be infringing claims 1-27,31 if the '837

application. Also, it is believed that if one were to infringe the pending claims 1-27,31, of the '837 application, one would necessarily be infringing claims 1-27,31 of the instant application. For claim 1, when compared to claim 1 of '837, the only difference is the inclusion in instant pending claim 1 of the language "parties other than" and this is not seen as changing the claim as far as what might be claimed as far as a system goes. The claims have been seen as reciting a system (which is also indefinite, see 112 rejection) that can track 1st, 2nd, and 3rd items. To this extent, the instant pending claims are claiming the same invention as claimed in the '837 application.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DeVries et al. (20030009396), Lindoerfer et al. (20020069096), Woolston (5845265), and Lau et al. (7212829) disclose systems that can track a plurality of items.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/

Primary Examiner, Art Unit 3689